

with tissue in the presence of an electrically conductive fluid." The Office Action continues to assert that none of the claims disclose or suggest a means to infuse electrically conductive fluids into the body and therefore the claim broadness infers that the conductive fluid is a natural fluid within the body. The Office Action concludes in stating that based upon the specification of the application, the fluid of the claims is limited to that which is infused into the body paragraph and that the claims should disclose or suggest elements in conformity with the specification.

Applicant disagrees with this rejection. Moreover, applicant disagrees with the Office Action's claim interpretation.

First, applicant notes that, the specification does not limit the invention to require infusion of electrically conductive fluid into the body by an element of the apparatus. Accordingly, to infer such a limitation on the claim is improper.

Second, Applicant is entitled to claim the invention in any manner permitted by 35 U.S.C. In support of applicant's ability to claim the invention as desired, applicant refers to M.P.E.P. §2171 and §2172 which state the proper criteria for a rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph for failure of the applicant to point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action fails to provide any evidence (apart from the specification) showing that the claims at issue do not correspond in scope with that which the applicant regards as the invention. Such a showing is required by the above cited M.P.E.P. sections. Merely stating that an applicant fails to claim the subject matter which applicant regarded as the invention and stating that a claim "should" be further limited is improper.

Based on the above, applicant believes that the above rejections based upon claims 1-14 and 27-35 are improper and should be withdrawn.

#### 35 U.S.C. §102

The Office Action rejected claim 18 under 35 U.S.C. §102(b) as being anticipated by Roos. Applicant disagrees.

Applicant is unable to find any teaching or suggestion in Roos of a device having one or more active low resistivity electrodes. In the absence of such a teaching, applicant requests either i) clarification as to the subject matter in Roos which the Office Action asserts to teach or suggest one or more active low resistivity electrodes; or ii) withdrawal of this rejection.

35 U.S.C. §103

The Office Action rejected claims 19 and 36 under 35 U.S.C. §103(a) as being unpatentable over Roos in view of Webster, Jr. Applicant disagrees.

As discussed above, Roos fails to anticipate claim 18. Moreover, Webster, Jr. fails to address the deficiencies in Roos. Claim 19 is dependent from claim 18, thus it contains all of the elements of claim 18. As a result, Roos fails to anticipate all of the elements of claim 19 and Webster, Jr. fails to remedy these deficiencies. In view of the above, this rejection should be withdrawn.

Regarding amended claim 36, neither Roos nor Webster, Jr. disclose a high frequency power supply adapted to generate a sufficient high frequency voltage difference between one or more of the active platinum electrode and the return electrode to generate a plasma adjacent to one of the active platinum electrode while maintaining a low temperature in the active platinum electrode. Accordingly, applicant believes this rejection is traversed.

SUMMARY

Applicant believes all outstanding issue raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,



Sanjay S. Bagade  
Reg. No. 42,280

ArthroCare Corporation  
680 Vaqueros Ave.  
Sunnyvale, CA 94085-3523  
(408) 736-0224

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the claims:**

Claim 36 is amended herein, a marked-up version of the amended claim is provided below:

36. (amended) A system for applying electrical energy to tissue at a target site comprising:

an electrosurgical instrument having a shaft with a proximal end, a distal end and one or more active platinum electrodes at the distal end of the shaft;

a return electrode; and

one or more connectors coupled to the active electrodes for connecting the active electrodes to a high frequency power supply, the high frequency power supply adapted to generate a sufficient high frequency voltage difference between one or more of the active platinum electrode and the return electrode to generate a plasma adjacent to one of the active platinum electrode while maintaining a low temperature in the active platinum electrode.